REMARKS

1. All outstanding requirements will now be addressed in the order they appear in the Office Action mailed March 15, 2010.

Priority

2. This application is a National Stage Application of International Patent Application No. PCT/CN 2004/001227, with an international filing date of October 28, 2004, which is based on Chinese Patent Application No. 200310106920.3, filed November 5, 2003.

In the Office action of July 14, 2009, the Examiner requested that Applicant provide a certified English version of the foreign priority documents. In the Office action of March 15, 2010, the Examiner reiterated the request for Applicant to provide "the English translation with certification." Accordingly, Applicant is submitting herewith an English language translation the Chinese Patent Application No. 200310106920.3 with a statement that the translation of the certified copy is accurate.

In light thereof, the Examiner is respectfully requested to confirm that the formal requirements for securing the right of priority to the foreign application have been complied with.

Claim Rejections – 35 USC § 112

3. Claims 1 stands rejected under 35 U.S.C. 112, second paragraph, because "the term HX is not defined since the Markush element 'X' is not found in the claim." Applicant has amended claim 1 to specifically define X. Withdrawal of the 112 rejection is respectfully requested.

4-1. Claims 1-6, and 11-22 stand rejected under 35 U.S.C. 112, first paragraph, as allegedly failing to comply with the enablement requirement. The Examiner provides a conclusory

statement that "[t]he exclusive disclosure of the *single* operable condition without variation is unsupportive that broad condition of using any strong acid in any amount with the known material submitted by applicants in the response on page 13/29 would be operable for the process."

Applicant respectfully reminds the Examiner that the presence of limited working examples (or even only one working example) should never be the sole reason for rejecting claims being broader than the enabling disclosure. To make a valid rejection, one must evaluate all the facts and evidence and state why one would not expect to be able to extrapolate the limited working examples (or that one example) across the entire scope of the claims. See, MPEP 2164.03. The Examiner has not provided any such statement or reasoning.

Since the claims are of rather limited scope (R^1, R^2, R^3, and R^4 are restricted only to H, F, C_{1-4} alkyl, or C_{1-4} alkoxy), since a variety of similar starting materials falling within the scope of Applicant's Markush structure for the starting material is known in the art, and since the anion X has now been restricted to an alkyl sulfonate, benzene sulfonate, a substituted benzene sulfonate, a chloride, a sulfate, a nitrate, or a phosphate, it is clear and convincing that experimentation would not be undue and that the claims are enabled. (See, MPEP 2164.01, "A patent need not teach, and preferably omits, what is well known in the art.")

In light thereof, withdrawal of the enablement rejection is respectfully requested.

4-2. Claims 23-24 stand rejected under 35 U.S.C. 112, first and second paragraph, because claim 23 provided no definition for element "X" and claim 24 allegedly contains new matter for the term "at least" stoichiometric amount of p-toluenesulfonic acid.

Applicant has amended claim 23 to define the anion X^- with more specificity. In addition, Applicant respectfully denies that the term "at least" stoichiometric amount of p-toluenesulfonic acid" is new matter. Specifically, in Example 1, 0.96 g (5 mmol) of 5,6-dimethoxy-1-indanone was reacted with 0.75 g (7 mmol) 4-pyridyl formaldehyde, and 0.95 g

(5.5 mmol) of p-toluenesulfonic acid, to form 2,3-dihydro-5,6-dimethoxy-2-((pyridine-4-yl)methylene)inden-1-one p-toluenesulfonic acid salt. Thus, in Example 1, a greater than a stoichiometric amount of p-toluenesulfonic acid was used. In addition, in Examples 2-6 a stoichiometric amount of p-toluenesulfonic acid was used. In light thereof, withdrawal of the 112 rejections is respectfully requested.

Claim Rejections – 35 USC § 102

5-1. Claims 1-2, 4-6, and 11-22 stand rejected under 35 U.S.C. 102(e) as being allegedly anticipated by Reddy et al. (US Pat 7,148,354).

Applicant re-alleges the arguments presented in previous replies. In addition, Applicant respectfully submits that even though a prior art may teach that a compound of formula III is formed in a catalytic amount the reaction medium, it does not follow that the prior art anticipates a process where the compound is used in a stoichiometric or greater than a stoichiometric amount. Withdrawal of the 102(e) rejection over the claims as amended is respectfully requested.

Claim Rejections – 35 USC § 103

5-2. Claims 1-2, 4-6, and 11-22 stand rejected under 35 U.S.C. 103(a) as being allegedly unpatentable over Lensky (US 5,606,064) in view of Devries '584 (WO 97/22584). Claims 1-6, and 11-22 stand rejected under 35 U.S.C. 103(a) as being allegedly unpatentable over Lensky in view of Devries '584 (WO 97/22584) and further in view of US Pat. No. 5,916,902 to Devries ("Devries '902"). Claims 1-6, and 11-22 stand rejected under 35 U.S.C. 103(a) as being allegedly unpatentable over Reddy in view of Devries '902.

Applicant re-alleges the arguments presented in previous replies. In addition, claim 1, as amended, now includes the limitation of specific strong acids and anion X, as well as a

quantitative limitation; and claims 15-20 include the limitation on catalyst. Withdrawal of the 103 rejections is respectfully requested.

CONCLUSION

In view of the foregoing amendments and remarks, Applicants submit that the pending claims are in condition for allowance. Early and favorable reconsideration is respectfully solicited. Should an extension of time be required, Applicants hereby petition for same and request that the extension fee and any other fee required for timely consideration of this submission only be charged to **Deposit Account No. 503182**.

Customer Number: **33,794**

Respectfully Submitted,

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